enclosing the SMS message into the common format message by the unified messaging server. The rejection adds Wong for the purported teaching of enclosing a message into a common format message.

Applicant traverses this rejection because there is ***no legal basis whatsoever*** for adding the teachings of Wong to the hypothetical combination of Patil and Ross.

Wong is not analogous art because there is no teaching whatsoever that is related to the inventors' field of endeavor, namely supplying ***messages*** to a subscriber independent of message format; further, Wong is not reasonably pertinent to the particular problem with which the inventors were involved, namely providing ***SMS messages*** to non-SMS device destinations.

As established in further detail below, Wong not only fails to provide any teaching or suggestion of an enclosing an SMS message into a common format message, as claimed, but Wong also fails to provide any teaching of enclosing any message whatsoever! Rather, Wong is ***solely related to*** performing call signaling for multimedia call setup methods for establishment of voice calls, fax calls, or video calls between a calling terminal and a called terminal: a Calling Agent ***constructs*** an e-mail **call setup message** using a destination e-mail address identified by an e-mail address resolution. Hence, Wong is not analogous art. In re Wood, 202 USPQ 171, 174 (CCPA 1979).

The Examiner's response to Applicant's assertion of Wong not being analogous art is insufficient: the Examiner's only response on page 17 of the Final Action is that "call setup is not excluded by the claims in question." This assertion is nonresponsive to Applicants arguments, and therefore insufficient under MPEP §707.07(f): "Where the applicant traverses any rejection,

the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Further, the Examiner's response demonstrates a **blatant** disregard for the claims as a whole, and the explicit teachings of the reference. As noted by the MPEP § 2141.01 (a), page 2100-122, the differences in structure and function of the inventions carry far greater weight in determining that a reference is not analogous art. Reliance on what is "not excluded" is legally improper and factually nonsensical.

Moreover, the piecemeal application of Wong in relying solely upon a supposed "encapsulation" is improper: Wong must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention (see MPEP 2141.02 at page 2100-95 (Rev. 1, Feb. 2000) (citing W.L. Gore & Associates, Inc. v. Garlock, Inc., 22 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984))).

Wong is directed to call setup procedures (i.e., signaling) during initiating of a call such as a voice call, fax call, video call, conference call, etc. (col. 1, lines 5-46). Wong describes that "[i]t would be desirable to be able to place calls of various types from a PSTN based terminal for example for connection to a data network based terminal, and call setup methods must be established for this" (column 1, lines 37-40). Since different telephony and communication networks having respective signaling protocols may be utilized, Wong teaches that a generic signaling system is used between a calling agent 114 and a called agent 116 in order to determine calling parameters including calling medium, quality, and terminal device address. (see, e.g., col. 1, lines 56-67, col. 2, lines 23-37).

Wong teaches that a multimedia call signaling method can be implemented based on

intercepting a call setup request from a calling terminal initiating a call (e.g., col. 1, lines 57-59), where the call setup request includes a called user identifier for identifying the called party (see col. 15, lines 56-57, col. 16, lines 24-26). The intercepted call setup request is sent to a calling agent 114, configured for performing an e-mail address resolution from the called user identifier (e.g., called number) to an e-mail address associated with the called user identifier, namely a unique Called Agent e-mail address that uniquely identifies the called agent 116 to be accessed for negotiating the call on behalf of the called party (col. 8, lines 5-8, 26-35 and 56-57; col. 9, lines 45-63; col. 13, lines 36-47; col. 16, lines 24-26).

An important aspect is that Wong does not enclose the original called user identifier specified in the original call setup request, but rather uses the original called user identifier to obtain a translation from the address database 186 to reach the unique called agent assigned to the called party:

> Each user has a one or more separate user identifiers for each type of network identifier for which the user has terminals. ... The purpose of the user identifier is to provide keys into the address database 186 which contains a mapping from user identifiers to MCSS Called Agent E-mail addresses. ***For each user*** of the MCSS provided by this embodiment of the invention, ***there will be a single unique designated Called Agent having a unique E-mail address***. Thus, for a user having a E.164 user identifier and an H.323 Internet address user identifier, the address database 186 will contain a translation from the E.164 user identifier ***to the Called Agent E-mail address***, and a translation from the H.323 Internet address user identifier ***to the Called Agent E-mail address***.
>
> (Col. 13, lines 30-32 and 37-47).

The Called Agent e-mail address associated with the called user identifier is then used by the calling agent 114 to ***construct*** a call setup e-mail message addressed to the called agent 116:

CALL SETUP E-mail MESSAGE

> In response to a call setup request, the Calling Agent 114 ***constructs*** a call setup E-mail message addressed to the E-mail address associated with the called user identifier. This involves filling in the <call-setup> field of the above described generic call signalling E-mail message as follows [subsequent MIME parameter details omitted].
>
> (Col. 16, lines 24-28).

As shown in cols. 16-17 of Wong, the calling agent 114 ***constructs*** an e-mail message having numerous generic key-value pairs that enables the called agent 116 assigned the Called Agent e-mail address to interpret and respond to the e-mail message by sending a reply message (col. 10, lines 36-43 and 61-67; col. 17, lines 29-35).

One having ordinary skill in the art, having read Wong ***in its entirety***, would conclude that Wong simply teaches ***translating*** a called user identifier specified in a call setup message into a ***Called Agent E-mail address*** for purposes of ***constructing*** an e-mail message by the calling agent 114 in order to perform call setup signaling using e-mail messages specifying universally-applicable messaging parameters in order to identify usable terminal devices and connection parameters.

As apparent from the foregoing, there is absolutely no disclosure or teaching whatsoever in Wong that would provide any suggestion to one having ordinary skill in the art to perform ***any encapsulation whatsoever***.

Hence, Wong does not disclose or suggest enclosing a message into a common format message, as asserted by the Examiner.

Moreover, there is no evidence of any motivation for one skilled in the art to add the

teachings of Wong to Patil and Ross: both Patil and Ross are directed to SMS **messages**, which involves exchanging messages between a source terminal and a destination terminal. Wong, however, is directed to call signaling for the purpose of setting up calls such as voice calls, video calls, etc. (see col. 1, lines 1-22). It is notoriously well known that there is ***no relation whatsoever*** between sending a one-way message (e.g., an e-mail message, SMS message, etc.), and establishing a two-way call connection for a voice, fax, or video call that requires signaling protocols for call setup procedures.

Moreover, the supposed motivation specified on page 4 ("for the advantage of making signaling protocols independent of each other") is without foundation and utter nonsense, since the hypothetical combination is directed to transport of SMS messages: no signaling protocols exist in transport of SMS messages because they are ***exclusively*** a requirement of call setup procedures for two-way call connections! There is no indication of any desirability whatsoever in the rejection to add the teachings of Wong. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990).

Further, one skilled in the art would conclude that there is no need to apply the teachings of Wong, since Ross already specifies with respect to Fig. 4 a canonical format for the received short messages, eliminating the necessity for any further conversion (see col. 8, lines 15-34 of Ross).

Hence, the Official Action fails to provide any evidence of any desirability to add the

teachings of Wong to the hypothetical combination of Patil and Ross. "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original).

In fact, the addition of Wong would interfere with the primary purpose of Patil and Ross, namely providing ***SMS messages***, by requiring the messages to be translated for the unnecessary purpose of evaluating whether call setup should be performed. There is no disclosure or suggestion that one skilled in the art would modify the hypothetical combination of Patil and Ross to add Wong, as claimed, since Wong is directed to call setup, and would interfere with the primary operation of the hypothetical combination related to SMS messaging.

Hence, if the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. MPEP § 2143.01, page 2100-132 (Rev. 2, May 2004) (citing In re Ratti, 123 USPQ 349 (CCPA 1959).

An evaluation of obviousness must be undertaken from the perspective of one of ordinary skill in the art addressing the same problems addressed by the applicant in arriving at the claimed invention. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, 23 USPQ 416, 420 (Fed. Cir. 1986), cert. denied, 484 US 823 (1987). Thus, the claimed structures and methods cannot be divorced from the problems addressed by the inventor and the benefits resulting from the claimed invention. In re Newell, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989). There is no disclosure in the hypothetical combination that a destination subscriber can receive an SMS message according to

any subscriber-selected protocol (see, e.g., page 4, lines 2-4 of the specification), based on generation of a common-format message that encloses the SMS message.

In fact, there is ***no disclosure or suggestion whatsoever*** in the hypothetical combination of ***"enclosing the SMS message"***, as claimed.

For these and other reasons, the rejection of claims 1, 6-12, 14-16, 35-36, 38-43, 48-54, 56-59, 64-70 and 72-74 should be withdrawn.

The rejection of claims 2-6, 20-21, 44-48, and 60-64 in view of Patil, Ross, Wong, and Tullis is respectfully traversed. The Final Action failed to address Applicant's assertion that Tulls is non-analogous art.

Tullis et al. is directed to office equipment configured for processing multimedia messages (e.g., image, audio, text, etc. mixed in a single message) (col. 1, lines 20-48), and is not within the field of the inventors' endeavor, namely providing a unified messaging system configured for supplying messages to a subscriber, independent of message format; further, Tullis et al.is not reasonably pertinent to the particular problem with which the inventors were involved, namely providing SMS messages to non-SMS device destinations. Tullis et al. provides no disclosure or suggestion of storing the common format message in a subscriber message store in a messaging folder selected based on the subscriber attribute information retrieved from a subscriber directory according to an open network protocol, and as such is non-analogous art. In re Wood, 202 USPQ 171, 174 (CCPA 1979).

For these and other reasons, this rejection should be withdrawn.

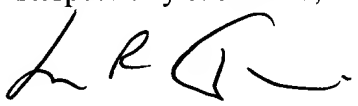
The indication of allowable subject matter in claims 13, 37, 55 and 71 is acknowledged. It is believed these claims are allowable in view of the foregoing.

The allowance of claims 17-34 and 75-76 is acknowledged with appreciation.

In view of the above, it is believed this application is and condition for allowance, and such a Notice is respectfully solicited.

To the extent necessary, Applicant petitions for an extension of time under 37 C.F.R. 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including any missing or insufficient fees under 37 C.F.R. 1.17(a), to Deposit Account No. 50-1130, under Order No. 95-455, and please credit any excess fees to such deposit account.

Respectfully submitted,



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